The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SUDHIR R. AHUJA,
MURALI ARAVAMUDAN,
and JAMES R. ENSOR

Appeal No. 1999-2057
Application 08/405,062[1]

ON BRIEF

Before KRASS, BARRETT, and GROSS, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

[1] Application for patent filed March 16, 1995, entitled "Multimedia Communications Network," which is a continuation of Application 08/052,492, filed April 22, 1993, now U.S. Patent 5,471,318, issued November 28, 1995.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-18.

We reverse.

BACKGROUND

The disclosed invention relates to a multimedia communications network capable of establishing a controllably persistent virtual meeting room. This virtual meeting room may be used to create voice, video, and data connections between multimedia meeting participants during a communication session.

Claim 1 is reproduced below.

> 1. A multimedia communications network, comprising:
>
> a plurality of multimedia ports, each for connecting the network to a user terminal;
>
> at least one meeting room server connected to the ports for creating an electronic circuit configuration in the network representing a controllably persistent virtual meeting room in response to commands from any of the user terminals, the virtual meeting room being controllably persistent such that it can exist in the network independent of participants of a meeting being connected to the network; and
>
> means responsive to the meeting room server for effectuating connections in one or more selected media between selected ones of the plurality of ports.

The Examiner relies on the following reference:

Rae et al. (Rae) 5,136,634 August 4, 1992

Claims 1-18 stand rejected under 35 U.S.C. § 112, first paragraph, as based on a nonenabling disclosure.

Claims 1-10 and 12-18 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Rae.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Rae.

We refer to the final rejection (Paper No. 5) and the examiner's answer (Paper No. 11) (pages referred to as "EA__") for a complete statement of the Examiner's position, and to the brief (Paper No. 9) (pages referred to as "Br__") for a statement of Appellants' arguments thereagainst.

OPINION

35 U.S.C. § 112, first paragraph, lack of enablement

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988) (citing Hybritech, Inc. v. Monoclonal

Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986)). A patent need not teach, and preferably omits, what is well known in the art. Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 804 F.2d 659, 664, 231 USPQ 649, 652 (Fed. Cir. 1986). The U.S. Patent and Trademark Office must support a rejection for lack of enablement with reasons. In re Wright, 999 F.2d 1557, 1561-62, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993).

The Examiner states (EA6-7):

> The claims are confusing for the reason that the virtual meeting room is not clearly defined by the written description. Since the virtual meeting room cannot be properly defined how can the virtual meeting room be controllably persistent?
>
> The examiner understands that since participants come and go, the ability of the participants to access the communication remains in tack [sic, intact], however, the "meeting room" cannot clearly be defined.

The Examiner's use of terms and phrases such as "confusing", "not clearly defined," "cannot be properly defined," and "cannot clearly be defined," make us question if the rejection is intended to be under 35 U.S.C. § 112, second paragraph, for indefiniteness rather than under § 112, first paragraph, for lack of enablement. Similarly, the Examiner statements in the remarks that the definition of virtual

meeting room is "misdescriptive" (EA10), "extremely vague and misdescriptive in defining a physical place" (EA10), and "[t]his definition does nothing to clear the confusion as to how the virtual meeting room is defined" (EA11), all appear more appropriate to § 112, second paragraph, indefiniteness rather than § 112, first paragraph, lack of enablement. Nevertheless, since the rejection is clearly stated to be under § 112, first paragraph, lack of enablement, we will only address this ground of rejection.

The Examiner does not provide any reasoning why the claimed subject matter could not be made without undue experimentation by one of ordinary skill in the art and, therefore, has not made even a colorable prima facie case of nonenablement. We have no trouble understanding the terminology of a "virtual meeting room" as referring to an electronic circuit configuration by which user workstations can communicate by data, audio, and video ports of a network; that is, the electronic interconnection of user terminals simulates a meeting room because participants can interact with one another via multimedia (data, audio, and video). Manifestly, there is no one physical "meeting room" location

because the participants are distributed, hence, the term "virtual meeting room." The configuration of the virtual meeting room is stored in a data structure as shown in Fig. 3. The Examiner's questioning of the definitions for the virtual meeting room (EA13-15) fails to appreciate that the electronic circuit configuration and the data structure "represent" (simulate) a virtual meeting room. The Examiner's interpretation of the disclosure that "[t]he virtual meeting room is thus an electronic analog of a physical meeting place where conferences are held" (specification, p. 5, lines 7-9), as referring to analog signals (EA14), clearly misapprehends the term "analog" as referring to analog signals, when, in fact, it means anything that is analogous or similar to something else. There is nothing confusing or misdescriptive about the claim terminology that would create nonenablement.

We have reviewed the specification, drawings, and Appellants' arguments, and conclude that the claimed subject matter is based on an enabling disclosure. For example, the circuit of Fig. 2 shows a network 10 having a plurality of multimedia ports (ports of data server 50, video server 54, and audio server 58), each for connecting the network to a

user terminal 12, 14, and a meeting room server 48 connected to the ports for creating an electronic circuit configuration in the network as recited in claim 1. The electronic circuit configuration, defined by the interconnection of ports and the virtual meeting room data structure (Fig. 3A), represents a controllably persistent virtual meeting room. We conclude that the Examiner has failed to establish a prima facie case of nonenablement. The rejection of claims 1-18 is reversed.

35 U.S.C. § 102(e)

"Anticipation is established only when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention." RCA Corp. v. Applied Digital Data Systems, Inc., 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

Claims 1-10, 12-16, and 18

Claims 1 and 18 are similar. Claim 1 is broader because it recites "means . . . for effectuating connections in one or more selected media between selected ones of the plurality of ports," whereas claim 18 more specifically recites "means for establishing voice, video, and data connections between at

least two of the ports." Claim 1 is analyzed as representative.

Rae is directed to a database retrieval method via facsimile with the assistance of voice prompts. We agree with Appellants that "[t]he configuration of the Rae apparatus does not even remotely attempt to simulate a meeting room or create a virtual meeting room(s) in a network" (Br10). Still, despite differences in structure, it is always possible that the claim language is so broad that it reads on Rae in an unintended manner.

We consider the claim limitations, noting that the absence of any limitation will cause the anticipation rejection to fail.

As to "a plurality of multimedia ports, each for connecting the network to a user terminal," the Examiner relies on nodes 1-n in Fig. 8 (EA7). Appellants argue that nodes 1-n are not multimedia ports for connecting the users to a (public switched telephone) network, but merely receive calls from a user of public switched telephone network.

The nodes are not ports for connecting the network to a user terminal. The "user terminal" is a facsimile

machine/telephone system 100 as in Fig. 1 which attaches to the public switched telephone network 77 in Fig. 8. The nodes merely receive calls from a user, perform call handling, voice processing, and facsimile transmission back to the user. It is possible that the user connection to the public switched telephone network are multimedia ports in the sense of handling both data (graphic and textual facsimile data) and audio (voice), two kinds of media, but this interpretation is not set out by the Examiner.

As to "at least one meeting room server connected to the ports for creating an electronic circuit configuration in the network representing a controllably persistent virtual meeting room in response to commands from any of the user terminals," the Examiner relies on server 73 in Fig. 8 as the meeting room server connected to the ports (nodes 1-n) (EA7). Appellants argue that the servers in Rae only provide data and processing instructions and cannot establish or maintain controllably persistent virtual meeting rooms (Br11). Appellants further argue that there is no evidence in Rae that callers can send commands to the server (Br10).

We agree with Appellants. The server 73 is connected to and receives commands from the control console 71, not the user terminals (element 100 in Fig. 1). As previously noted, nodes 75 in Fig. 8 are not user terminals. The server cannot establish a virtual meeting room, much less a controllably persistent virtual meeting room, because the users merely receive graphic and textual facsimile data stored on the nodes 75: they do not communicate with other users. There is no attempt to simulate a virtual meeting room where users can interact.

As to "the virtual meeting room being controllably persistent such that it can exist in the network independent of participants of a meeting being connected to the network," we do not find where the Examiner addresses this limitation. Appellants argue that there is no suggestion of "persistence" in Rae, because Rae is a real-time access system where once the caller hangs up, the apparatus in Rae loses everything about the call (Br12). The Examiner responds that there is nothing in the claims about persistence based on a caller receiving data from a facsimile machine (EA16).

We agree with Appellants. The Examiner misses the point of Appellants' argument about the facsimile machine. There is nothing in Rae about a virtual meeting room (or other kind of connection) persisting "independent of participants of a meeting being connected to the network," as claimed.

As to "means responsive to the meeting room server for effectuating connections in one or more selected media between selected ones of the plurality of ports," in which "connections . . . between selected ones of the . . . ports" requires a connection between at least two ports connected to user terminals, the closest comment we find is the assertion with respect to claim 3 that "it is clear to see that plural users, two or more, can interact given the instructions received by the server" (EA8). Appellants argue that the callers in Rae can simply access a host computer's database and cannot meet or communicate or otherwise interact with other callers (Br12).

We agree with Appellants. The users in Rae can only interact with the database to receive facsimile information and cannot interact with each other.

For the reason stated above, we conclude that the Examiner erred in finding anticipation. The anticipation rejection of claims 1-10, 12-16, and 18 is reversed.

Claim 17

Claim 17 is directed to the user terminal 12 or 14 of Fig. 2 and recites a user interface, a conversation manager connected to the user interface for connection with a meeting room server in the communications network, a data manager, a video manager, and a voice manager. Appellants argue that Rae does not show or suggest these features and that all Rae refers to is a user terminal having a telephone and facsimile machine (Br14-15). It is argued that Rae does not show video data (Br10). The Examiner finds that the user terminal having a telephone and facsimile machine handles "voice (audio), graphic (video) and textual data (data)" (EA8), referring to column 6, lines 25-69, of Rae, and that "[g]raphic data is synonymous with video" (EA17).

The telephone and facsimile machine 100 in Fig. 1 of Rae handles voice by telephone and data by facsimile machine. However, the Examiner errs in finding (EA8; EA15) that "graphic data" in Rae is "video." Rae discloses storage and

transmission of "graphic and textual facsimile data" (col. 6, line 33), i.e., graphic facsimile data and textual facsimile data, which both fall into the category of data. The Examiner misinterprets "graphic . . . facsimile data" as "graphic data to be that other than fax and voice data" (EA17). "Video" refers to the component of a television signal that contains the picture information. Because Rae does not disclose at least "a video manager for connecting the conversation manager with a video server in the network," it does not anticipate claim 17. The anticipation rejection of claim 17 is reversed.

35 U.S.C. § 103(a)

The Examiner's obviousness reasoning with respect to claim 11 does not cure the deficiencies of Rae with respect to claim 1. The obviousness rejection of claim 11 is reversed.

CONCLUSION

The rejections of claims 1-18 are reversed.

REVERSED

ERROL A. KRASS Administrative Patent Judge	)	
LEE E. BARRETT Administrative Patent Judge	)	BOARD OF PATENT APPEALS AND INTERFERENCES
ANITA PELLMAN GROSS Administrative Patent Judge	)	

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